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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,782	02/28/2005	Michael Neumann	026032-4855	8507
26371	7590	10/17/2006	EXAMINER	
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306			HAN, JASON	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/525,782	NEUMANN, MICHAEL	
	Examiner	Art Unit	
	Jason M. Han	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050228, 20050531</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because Figure 2 fails to show "interior 4" as defined in the specification [Page 5, Line 32]. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:
- a. Section titles are inappropriate and not standard to U.S. patent applications;

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- b. Page 1, Line 22: Grammatical error – “Sufficiently thinly”;
- c. Page 5, Lines 22-23: Grammatical error – “elastically compressibly”;
- d. Page 5, Line 36: Grammatical error – “directly very uniformly”;

Numerous grammatical errors are replete throughout the application. The examiner has forgone any correction due to the amount, and the specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Objections

3. Claim 16 is objected to because of the following informalities: The preamble is missing a transitional phrase (i.e., comprising, consisting, etc.). Appropriate correction is required, whereby the Examiner has assumed the open-ended “comprising” as the transitional phrase in the rejection below.

4. Claim 20 is objected to because of the following informalities: Grammatical error – “electroluminescent film organic light-emitting diode and poly light-emitting diode”.

Appropriate correction is required.

5. Claims 21, 24, 36, and 44 are objected to because of the following informalities: Applicant should avoid the use of acronyms (by themselves) to prevent confusion.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationship: "an elastomer has an at least partially foamed structure" has not been defined or shown how it is related to the other structural components previously cited in the claims.

8. Claim 19 recites the limitation "the gel-like substance is arranged between two plastic films" in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim. At present, an appropriate prior art search cannot be conducted until amendment, where Applicant provides elucidation.

9. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant already cites in Independent Claim 16, which Claim 29 is dependent off of, "a translucent covering layer".

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The following claims have been rejected in light of the specification, but rendered the broadest interpretation as construed by the Examiner and as stated by the Applicant within the context of the claim language [MPEP 2111].

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 16-17, 20-21, 23-25, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al. (U.S. Patent 5,895,115).

11. With regards to Claim 16, Parker discloses an lighting element for a vehicle including:

- A base part [Figure 8: (9, 52 and/or 48)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figure 8: (49)]; and
- A translucent covering layer [Figure 8: (51 and/or 48)], wherein the covering layer is designed to be elastically compressible [Column 10, Lines 23-27].

12. With regards to Claim 17, Parker discloses the base part including a light generator [Figure 8: (9)].

13. With regards to Claim 20, Parker discloses the base part including a poly light-emitting diode [Figure 8: (9); Column 5, Lines 1-23].

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14. With regards to Claim 21, Parker discloses the translucent covering layer [Figure 8: (51)] including an elastomer that could be one of silicone [Column 7, Lines 60-62].

15. With regards to Claim 23, Parker discloses the base part being designed as a plate-like optical conductor [Figure 7: (40)], which is operationally associated with a light generator [Figure 7: (9)].

16. With regards to Claim 24, Parker discloses the optical conductor being a polycarbonate [Column 9, Lines 50-52], and having a structure allowing an output of light on the surface side of the optical conductor facing the interior of a vehicle.

17. With regards to Claim 25, Parker discloses the covering layer [Figure 8: (51)] including a layer of a gel-like substance [Column 10, Line 24; Column 7, Line 62] covered toward the interior of the vehicle by a plastic film [Column 5, Lines 45-53; Column 7, Lines 27-35].

18. With regards to Claim 29, Parker discloses the covering layer being translucent [Figure 8: (51); Column 10, Lines 18-19].

19. Claims 31-33, 35-36, 38, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al. (U.S. Patent 5,895,115).

20. With regards to Claim 31, Parker discloses a lighting element including:

- A base part [Figure 8: (9, 52 and/or 48)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figure 8: (49)]; and
- A covering layer [Figure 8: (51 and/or 48)].

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21. With regards to Claim 32, Parker discloses the covering layer being elastically compressible [Column 10, Lines 23-27].

22. With regards to Claim 33, Parker discloses the covering layer being translucent [Column 10, Lines 18-19].

23. With regards to Claim 35, Parker discloses the translucent covering layer including an elastomer having an at least partially formed structure [Column 10, Lines 23-24].

24. With regards to Claim 36, Parker discloses the translucent covering layer [Figure 8: (48, 51)] including an elastomer that could be one of silicone [Column 7, Lines 60-62].

25. With regards to Claim 38, Parker discloses the covering layer [Figure 8: (48, 51)] including a layer of a gel-like substance [Column 10, Line 24; Column 7, Line 62] covered toward the interior of the vehicle by a plastic film [Column 5, Lines 45-53; Column 7, Lines 27-35].

26. With regards to Claim 44, Parker discloses the base plate being a plate-like optical conductor [Figure 7: (40)] comprising of a polycarbonate [Column 9, Lines 50-52].

27. With regards to Claim 45, Parker discloses the base part being a light generator, such as a poly light-emitting diode [Figure 8: (9); Column 5, Lines 1-23].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (U.S. Patent 5,895,115) as applied to Claim 21 above, and further in view of Miller (U.S. Patent 6,227,689 B1).

Parker discloses the claimed invention as cited above, but does not specifically teach the elastomer having a hardness of 20 to 70 Shore A.

Miller teaches, "Preferably, body 16 of bulb holder 10 is injection molded with at least two stampings 46. Body 16 may be molded from a flexible polymeric material, preferably having a Shore A durometer hardness of between approximately 50 Shore A and 105 Shore A, more preferably between approximately 60 Shore A and 90 Shore A, and most preferably approximately 60 Shore A, such as a thermoplastic elastomer (TPE) material, such as Kraton G7720B or the like. Alternatively, a plasticized poly vinyl chloride (PVC) material, a flexible urethane, a silicone or the like may be used, without affecting the scope of the present invention. By injection molding of body 16 with the stampings within the flexible material, the present invention assures a water-tight construction to substantially preclude water from entering the terminals 20 and 24 within body 16" [Column 5, Lines 29-44].

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the lighting element of Parker, specifically the elastomer, to incorporate the Shore durability characteristics, as principally taught by Miller, so as to ensure appropriate hardness and flexibility of the elastomer. It has also been held that where the general conditions of a claim are disclosed in the prior art, discovering the

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optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

29. Claims 26-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (U.S. Patent 5,895,115).

Parker discloses the claimed invention as cited above, but does not specifically teach the plastic film on the side of the interior having a thickness of 0.1 to 1.5 mm (re: Claim 26); the covering element having an overall thickness of 1.0 to 5.0 mm (re: Claim 27); the gel-like substance having a dynamic viscosity of 0.01 to 10 Pa·s (re: Claim 28); nor teaches the translucent covering layer having an optical transmissivity in the visible spectral range of 1 to 25% (re: Claim 30).

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the plastic film on the side of the interior to have a thickness of 0.1 to 1.5 mm; the covering element to have an overall thickness of 1.0 to 5.0 mm; the gel-like substance to have a dynamic viscosity of 0.01 to 10 Pa·s; and the translucent covering layer to have an optical transmissivity in the visible spectral range of 1 to 25% (re: Claim 30), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In this case, one would want the film/covering element to be of a relatively thinness, as corroborated by Parker [Column 8, Lines 35-39, 57-59]; to ensure that the gel-like substance is relatively flexible or deformable; and to provide the translucent covering layer with an optical transmissivity for its intended purpose, such as a non-overbearing illumination.

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30. Claims 34, 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (U.S. Patent 5,895,115).

31. With regards to Claim 34, Parker discloses the claimed invention as cited above, but does not specifically teach the translucent covering layer having an optical transmissivity in the visible spectral range of 5 to 10%.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the translucent covering layer to have an optical transmissivity in the visible spectral range of 5 to 10%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In this case, one would want to provide the translucent covering layer with an optical transmissivity for its intended purpose, such as a non-overbearing illumination.

32. With regard to Claims 39 and 41, Parker discloses the claimed invention as cited above. In addition, Parker teaches the gel-like substance being arranged between two plastic films [Column 5, Lines 49-53; Column 7, Lines 22-26]. Parker does not specifically teach the film(s) being plastic.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the films out of plastic, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. In this case, the availability of plastic is conducive to manufacturability.

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33. With regard to Claims 40 and 42-43, Parker discloses the claimed invention as cited above, but does not specifically teach the gel-like substance having a dynamic viscosity of 0.1 to 1 Pa·s (re: Claim 40); the plastic film having a thickness of approximately 0.5 to 1.0 mm (re: Claim 42); nor teaches the covering layer having a thickness overall of approximately 2.0 to approximately 3.0 mm (re: Claim 43).

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the gel-like substance to have a dynamic viscosity of 0.1 to 1 Pa·s; the plastic film to have a thickness of approximately 0.5 to 1.0 mm; and the covering layer to have a thickness overall of approximately 2.0 to approximately 3.0 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In this case, one would want to ensure that the gel-like substance is relatively flexible or deformable, as well as the film/covering element to be of a relatively thinness, as corroborated by Parker [Column 8, Lines 35-39, 57-59].

34. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (U.S. Patent 5,895,115) as applied to Claim 35 above, and further in view of Miller (U.S. Patent 6,227,689 B1).

Parker discloses the claimed invention as cited above, but does not specifically teach the elastomer having a hardness of APPROXIMATELY (broad interpretation – MPEP 2111) 40 Shore A.

Miller teaches, "Preferably, body 16 of bulb holder 10 is injection molded with at least two stampings 46. Body 16 may be molded from a flexible polymeric material, preferably having a Shore A durometer hardness of between approximately 50 Shore A and 105 Shore A, more preferably between approximately 60 Shore A and 90 Shore A, and most preferably approximately 60 Shore A, such as a thermoplastic elastomer (TPE) material, such as Kraton G7720B or the like. Alternatively, a plasticized poly vinyl chloride (PVC) material, a flexible urethane, a silicone or the like may be used, without affecting the scope of the present invention. By injection molding of body 16 with the stampings within the flexible material, the present invention assures a water-tight construction to substantially preclude water from entering the terminals 20 and 24 within body 16" [Column 5, Lines 29-44].

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the lighting element of Parker, specifically the elastomer, to incorporate the Shore durability characteristics, as principally taught by Miller, so as to ensure appropriate hardness and flexibility of the elastomer. It has also been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

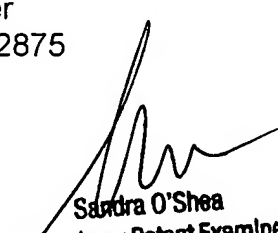
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M Han
Examiner
Art Unit 2875

JMH (10/13/2006)



Sandra O'Shea
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